

1 PAUL, HASTINGS, JANOFSKY & WALKER LLP
2 NED N. ISOKAWA (SB# 66287)
3 nedisokawa@paulhastings.com
4 JASON K. SONODA (SB# 248105)
5 jasonsonoda@paulhasting.com
6 55 Second Street, Twenty-Fourth Floor
7 San Francisco, CA 94105-3441
8 Telephone: (415) 856-7000
9 Facsimile: (415) 856-7100

6 MCKOOL SMITH, P.C.
7 THEODORE STEVENSON, III (*pro hac vice* application to be filed)
8 tstevenson@mckoolsmith.com
9 SCOTT W. HEJNY (*pro hac vice* application to be filed)
10 shejny@mckooksmith.com
11 LUKE F. MCLEROY (*pro hac vice* application to be filed)
12 lmcleroy@mckoolsmith.com
13 300 Crescent Court, Suite 1500
14 Dallas, TX 75201
15 (214) 978-4000
16 (214) 978-4044 (fax)
17 www.mckoolsmith.com

13 Attorneys for Defendant
14 i2 Technologies, Inc.

15 UNITED STATES DISTRICT COURT
16 NORTHERN DISTRICT OF CALIFORNIA
17 SAN FRANCISCO DIVISION
18

19 SAP AKTIENGESELLSCHAFT, A
20 German corporation,

21 Plaintiff,

22 vs.

23 i2 TECHNOLOGIES, INC., a Delaware
24 corporation,

25 Defendant.

CASE NO. 3:07-cv-04187-JCS

**DEFENDANT i2'S ANSWER AND
COUNTERCLAIMS TO PLAINTIFFS'
FIRST AMENDED COMPLAINT FOR
PATENT INFRINGEMENT**

DEMAND FOR JURY TRIAL

26 Defendant i2 Technologies, Inc. ("i2") hereby answers SAP Aktiengesellschaft's
27 ("Plaintiff's") First Amended Complaint for Patent Infringement ("Complaint") as follows:
28

NATURE OF THE ACTION

1
2 1. i2 admits that the present case is an action for patent infringement of U.S. Patent
3 Nos. 6,407,761 ("the '761 patent") and 6,750,766 ("the '766 patent"). i2 denies that remaining
4 allegations in Paragraph 1 of the Complaint.
5

PARTIES

6
7 2. i2 lacks knowledge or information sufficient to form a belief as to the truth of the
8 allegations in Paragraph 2 of the Complaint and, therefore, denies the same.
9

10 3. i2 admits that it is a Delaware Corporation with a place of business at 11701 Luna
11 Road, Dallas, Texas 75234. i2 also admits that it has an office at 1250 Oakmead Parkway, Suite
12 210, Sunnyvale, California 94085.

SUBJECT MATTER JURISDICTION

13
14 4. i2 admits that this Court has subject matter jurisdiction over this dispute. i2 denies
15 the remaining allegations contained in Paragraph 4 of the Complaint.
16

VENUE

17
18 5. i2 admits that venue is proper in this Court pursuant to 28 U.S.C. §§ 1391 and
19 1400. i2 denies that venue is convenient for the parties and witnesses or in the interest of justice
20 and reserves its right to challenge venue under 28 U.S.C. § 1404.
21

FIRST CLAIM FOR RELIEF

(Infringement of the '761 Patent)

22
23
24 6. i2 incorporates by reference its responses to Paragraphs 1-5 above.

25 7. i2 admits that the '761 patent is entitled "System and Method for the Visual
26 Customization of Business Object Interfaces" and issued on June 18, 2002, but denies that the
27 '761 patent was duly and legally issued. i2 lacks knowledge or information sufficient to form a
28

1 belief as to the truth of the remaining allegations in Paragraph 7 of the Complaint and, therefore,
2 denies the same.

3 8. i2 denies the allegations contained in Paragraph 8 of the Complaint.

4 9. i2 denies the allegations contained in Paragraph 9 of the Complaint.

5
6 **SECOND CLAIM FOR RELIEF**

7 **(Infringement of the '766 Patent)**

8 10. i2 incorporates by reference its responses to Paragraphs 1-5 above.

9 11. i2 admits that the '766 patent is entitled "Alerts Monitor" and issued on June 15,
10 2004, but denies that the '766 patent was duly and legally issued. i2 lacks knowledge or
11 information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 11
12 of the Complaint and, therefore, denies the same.

13 12. i2 denies the allegations contained in Paragraph 12 of the Complaint.

14 13. i2 denies the allegations contained in Paragraph 13 of the Complaint.

15
16 **PRAYER FOR RELIEF**

17 14. i2 denies that Plaintiff is entitled to any form of relief, including that sought in
18 Plaintiff's prayer for relief.

19
20 **FIRST AFFIRMATIVE DEFENSE**

21 15. i2 does not infringe and has not infringed any of the Patents in Suit.

22 **SECOND AFFIRMATIVE DEFENSE**

23 16. The claims of the Patents in Suit are invalid and unenforceable for failing to satisfy
24 one or more conditions of patentability set forth in Part II of Title 35 of the United States Code,
25 including but not limited to Sections 101, 102, 103, and/or 112.

THIRD AFFIRMATIVE DEFENSE

17. Plaintiff is estopped from construing any valid claim of the Patents in Suit to cover or include, either literally or by application of the doctrine of equivalents, any product, method or system manufactured, used, imported, sold, or offered for sale by i2 because of admissions and statements made to the United States Patent and Trademark Office ("USPTO") or because of amendments made to the claims of the Patents in Suit or related patents during the prosecution of the applications leading to the issuance of the Patents in Suit or related patents.

FOURTH AFFIRMATIVE DEFENSE

18. Plaintiff is estopped by reason of prosecution history estoppel from asserting infringement of the Patents in Suit by application of the doctrine of equivalents.

FIFTH AFFIRMATIVE DEFENSE

19. Plaintiff is not entitled to injunctive relief because any alleged injury to the Plaintiff is not immediate or irreparable, and Plaintiff has an adequate remedy at law.

COUNTERCLAIMS

For its Counterclaims against SAP Aktiengesellschaft ("Counterclaim-Defendant"), Counterclaim-Plaintiff i2 alleges as follows:

JURISDICTION

1. This is an action for Declaratory Relief for which this Court has jurisdiction under 28 U.S.C. §§ 1331, 1338, 1367(a), and 2201.

2. This Court has personal jurisdiction over Counterclaim-Defendant. Counterclaim-Defendant has consented to the personal jurisdiction of this Court by bringing this action.

VENUE

3. Venue for i2's Counterclaims is proper in this judicial district pursuant to 28 U.S.C. § 1391. Counterclaim-Defendant has also consented to venue in this Court by bringing this action.

PARTIES

4. i2 Technologies, Inc. ("i2") is a Delaware Corporation with a place of business at 11701 Luna Road, Dallas, Texas 75234. i2 also has an office at 1250 Oakmead Parkway, Suite 210, Sunnyvale, California 94085.

5. Upon information and belief, Counterclaim-Defendant SAP Aktiengesellschaft is a German corporation with its headquarters at Dietmar-Hopp-Allee 16, 69190, Walldorf, Germany. Upon information and belief, SAP is that parent company of SAP America, Inc., which in turn is the parent of SAP Labs, LLC, a subsidiary headquartered at 3475 Deer Creek Road, Palo Alto, California.

6. By its Complaint, Counterclaim-Defendant purports to be the owner of United States Patent Nos. 6,407,761 ("the '761 patent") and 6,750,766 ("the '766 patent") (collectively, "the Patents in Suit"), and to assert claims against i2 for infringement of the Patents in Suit.

BACKGROUND

7. Counterclaim-Defendant sued i2 for alleged infringement of the Patents in Suit in this Court on August 15, 2007.

8. i2 has denied Counterclaim-Defendant's claims of infringement and contends that the Patents in Suit are invalid and unenforceable under Title 35 of the United States Code.

9. An actual controversy has arisen and now exists between i2 and Counterclaim-Defendant as to the non-infringement, invalidity, and unenforceability of the Patents in Suit.

COUNT I - DECLARATION OF NON-INFRINGEMENT

10. Counterclaim-Defendant in this action has asserted that i2 is infringing the Patents in Suit by manufacturing, using, importing, marketing, selling, reselling, offering for sale, and/or inducing others to use products falling within the scope of the claims of one or more of the Patents in Suit.

11. No product made, used, imported, marketed, sold, resold, and/or offered for sale by i2 infringes any claim of the Patents in Suit.

12. i2 seeks a declaration that it has not infringed and does not infringe the Patents in Suit, either literally or under the doctrine of equivalents.

COUNT II - DECLARATION OF PATENT INVALIDITY

13. The claims of the Patents in Suit are invalid for failure to satisfy the provisions of Title 35 of the United States Code, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, and/or 112.

14. i2 seeks a declaration that the Patents in Suit are invalid and/or unenforceable.

PRAYER FOR RELIEF

WHEREFORE, having fully answered and counterclaimed, i2 prays for judgment as follows:

A. That this Court enter judgment in favor of i2 on Plaintiff's claims against i2 and order that Plaintiff take nothing from i2;

B. That this Court find and declare that i2 has not infringed any claim of the Patents in Suit;

C. That this Court find and declare that the Patents in Suit are invalid and/or unenforceable;

1 D. That this Court award i2 all of its costs of this action;

2 E. That this Court find that this is an exceptional case and award i2 its attorneys' fees
3 pursuant to 35 U.S.C. § 285 or otherwise; and

4 F. That this Court grant i2 such other and further relief as the Court shall deem just
5 and proper.
6

7 Dated: October 12, 2007

PAUL, HASTINGS, JANOFSKY & WALKER LLP

9 By: /s/ Ned N. Isokawa
10 Ned N. Isokawa

11 OF COUNSEL:

12 MCKOOL SMITH, P.C.

13 Theodore Stevenson, III (pro hac vice application to be
14 filed)

Scott W. Hejny (pro hac vice application to be filed)

15 Luke F. McLeroy (pro hac vice application to be filed)

16 Attorneys for Defendant
17 i2 Technologies
18
19
20
21
22
23
24
25
26
27
28

DEMAND FOR JURY TRIAL

Counterclaim-Plaintiff i2 requests a trial by jury on all issues so triable.

Dated: October 12, 2007

PAUL, HASTINGS, JANOFSKY & WALKER LLP

By: /s/ Ned N. Isokawa
Ned N. Isokawa

OF COUNSEL:

MCKOOL SMITH, P.C.

Theodore Stevenson, III (*pro hac vice* application to be filed)

Scott W. Hejny (*pro hac vice* application to be filed)

Luke F. McLeroy (*pro hac vice* application to be filed)

Attorneys for Defendant
i2 Technologies

LEGAL_US_W # 57294851.1

PROOF OF SERVICE BY ELECTRONIC MAIL

I am a citizen of the United States and employed in San Francisco County, California. I am over the age of eighteen years and not a party to the within-entitled action. My business address is 55 Second Street, Twenty-Fourth Floor, San Francisco, California 94105-3441.

On October 12, 2007, I served a true and correct copy of

DEFENDANT i2'S ANSWER AND COUNTERCLAIMS TO PLAINTIFFS' FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT

DISCLOSURE OF i2 TECHNOLOGIES, INC. PURSUANT TO FEDERAL RULE OF CIVIL PROCEDURE 7.1

☒ **VIA ELECTRONIC MAIL:**

Pursuant to the operation of the U.S. District Court for the Northern District of California E-Filing system, all parties above have been served via e-mail; per Local Rule 5-4 and General Order 45.

as follows:

Michael J. Sackseder
Fenwick & West LLP
555 California Street, Suite 1200
San Francisco CA 94104

Hector J. Ribera
Fenwick & West LLP
Silicon Valley Street
801 California Street
Mountain View, CA 94041

Lynn Harold Pasahow
Fenwick & West LLP
Silicon Valley Street
801 California Street
Mountain View, CA 94041

Saina Sason Shamilov
Fenwick & West LLP
Silicon Valley Street
801 California Street
Mountain View, CA 94041

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct. Executed on October 12, 2007, at San Francisco, California.

By: /s/ Laura M. Raabe
Laura M. Raabe

LEGAL_US_E # 76795806.1